REMARKS

I. INTRODUCTION

Claims 1-6, 11-17, 19 and 20 have been amended. The drawings have also been amended. Thus, claims 1- 21 remain pending in the present application. No new matter has been added. In light of the above amendments and the following remarks, Applicants respectfully submit that all presently pending claims are in condition for allowance.

II. INFORMATION DISCLOSURE STATEMENT

The Examiner states that the information disclosure statement filed on 3/15/2006 fails to comply with 37 C.F.R. §§ 1.97 and 1.98 and MPEP § 609. Please find a corrected information disclosure statement enclosed herewith.

III. THE DOUBLE PATENTING REJECTION SHOULD BE WITHDRAWN

Claim 1 stands rejected on the grounds of nonstatutory obviousness-type double patenting as being unpatentable over copending published application No. 2006/0100987 in view of Hane (U.S. Published App. No. 2004/0083490). In light of the terminal disclaimer enclosed herewith, the withdrawal of this rejection is respectfully requested.

IV. THE DRAWING OBJECTION SHOULD BE WITHDRAWN

The drawings stand objected to under 37 C.F.R. §1.83(a) for failing to show the structural relationships of the claims. In light of the amendments to the drawings, the withdrawal of this objection is respectfully requested.

V. THE 35 U.S.C. § 101 REJECTIONS SHOULD BE WITHDRAWN

Claims 1-18 stand rejected under 35 U.S.C. §101 for being directed towards non-statutory subject matter. (See 1/27/09 Office Action, pp. 4-5). Specifically, the

Examiner asserts that a method/process claim must be tied to another statutory class of invention or transform underlying subject matter to a different state or thing. (See Id.).

Claim 1 is currently amended to recite "determining, by a user profile processor, a user preference profile for a user" and "determining, by a recommender processor, if a first content correlates with the user preference profile to determine if the first content has a high preference value." The amendments recite a user profile processor and a recommender processor and are supported by at least paragraph [0038] of the Specification. Accordingly, claim 1 is tied to another statutory class, namely, a processor. Thus, Applicants respectfully submit that the rejection of claim 1 should be withdrawn. As claims 2-18 depend from, and therefore include all the limitations of claim 1, it is hereby submitted that these claims are also allowable.

Claims 19 and 21 stand rejected under 35 U.S.C. §101 for attempting to claim more than one statutory category. Applicants respectfully submit that this is not a proper rejection. There is no requirement that any claim be limited to only one of the statutory categories. Applicants direct the Examiner to the following:

> For example, a claimed invention may be a combination of devices that appear to be directed to a machine and one or more steps of the functions performed by the machine. Such instances of mixed attributes, although potentially confusing as to which category of patentable subject matter the claim belongs, does not affect the analysis to be performed by USPTO personnel. Note that an apparatus claim with process steps is not classified as a "hybrid" claim; instead, it is simply an apparatus claim including functional limitations.

> See, MPEP § 2106 IV B

However, in the interest of expediting prosecution, claim 19 has been rewritten as a standard statutory Beauregard claim. As described above, claim 21 does not run afoul of any statutory requirement. Thus, it is respectfully submitted that both claims 19 and 21 are allowable.

Claim 20 stands rejected under 35 U.S.C. §101 because the Examiner is uncertain what statutory class a recommender falls under. Again, as described above, it is not necessary for the Examiner to state which of the four categories the claimed subject matter falls into, but rather whether it falls outside of the statutory classes. See, MPEP § 2106 IV B. The Examiner has not asserted that the subject matter of claim 20 falls outside the statutory classes, just that the Examiner cannot determine to which class it belongs. As such, the rejection under 35 U.S.C. §101 is improper. Thus, Applicants respectfully submit that the rejection of claim 20 should be withdrawn.

VI.   THE 35 U.S.C. § 112 REJECTION SHOULD BE WITHDRAWN

Claims 1-21 stand rejected under 35 U.S.C. §112, second paragraph, for being indefinite. In light of the amendments to the claims, the withdrawal of this rejection is respectfully requested.

VII.   THE 35 U.S.C. § 102(e) REJECTION SHOULD BE WITHDRAWN

Claims 1-11 and 15-19 stand rejected under 35 U.S.C. §102(e) for being anticipated by Hane (U.S. Published App. No. 2004/0083490).

Claim 1 recites, "[a] method of providing a recommendation of content to a user carried out by a processor, the method comprising the steps of: determining a user preference profile for a user; determining if a first content correlates with the user preference profile to determine if the first content has a high preference value; and if the first content has a high preference value recommending the first content to a user; and *if the first content does not have a high preference value: determining if the first content comprises at least a first characteristic having an associative correspondence to at least a second characteristic of a second content having a high user preference and recommending the first content to the user only if there is such an associative correspondence.*"

Hane teaches the creation of a plurality of user profiles that show "the characteristics of [a] user's favorite programs." (See Hane, p. 5, ¶ [0109]). These user profiles each emphasize different points than each other and the emphasized point "is set in advance by the user." (See Id., ¶ [0110]). So, the user in Hane emphasizes a point in each user profile. In fact, Hane explicitly discloses that "[t]he user operated the operational unit 110 to specify the emphasized point, for determining programs to be recommended." Subsequently, "the system controller 111 carries out a process of determining programs to be recommended." (See Id., p. 6, ¶¶ [0135]-[0136]). Therefore, the determination of what programs are recommended to the user is based on the emphasized point, which is specified by the user.

In contrast, claim 1 recites "if the first content does not have a high preference value: determining *if the first content comprises at least a first characteristic having an associative correspondence to at least a second characteristic of a second content having a high user preference and recommending the first content to the user only if there is such an associative correspondence*." The Hane disclosure is centered around the emphasized point specified by the user. However, even if the emphasized point of the user profiles of Hane were not specified by the user, there is no disclosure by Hane of the associative correspondence of claim 1.

Furthermore, the Examiner states that hane teaches that "programs that are not ranked high when initially correlated with the user preference profile is reanalyzed in order to determine whether the program should continue to be recommended to the user based on various stored parameters [characteristics], including previous programs that have been stored/viewed." (See 1/27/09 Office Action pp. 8-9). Applicants disagree with the Examiner's interpretation of Hane. All Hane does is cycle through various EPG vectors for various programs. (See Hane, pp. 6-7, ¶¶ [0133] – [0149]). However, this cycling does not relate characteristics of one program to characteristics of another program. It merely searches for the emphasized point in various locations. Accordingly, Hane netiher teaches nor suggests "if the first content does not have a high preference value: determining *if the first content comprises at least a first characteristic having an*

associative correspondence to at least a second characteristic of a second content having a high user preference and recommending the first content to the user only if there is such an associative correspondence" as recited in claim 1. Therefore, Applicants respectfully submit that claim 1 and its dependent claims 2-11 and 15-18 are allowable over Hane.

It is respectfully submitted that claim 19 is allowable for the same reasons a s claim 1.

VIII. THE 35 U.S.C. 103(a) REJECTIONS SHOULD BE WITHDRAWN

Claims 12-14 stand rejected under 35 U.S.C. §103(a) for being obvious over Hane in view of Nicky Blackburn (Innovations; [Daily Edition]). Claims 20-21 stand rejected under 35 U.S.C. §103(a) for being obvious over Hane in view of Robert Cravotta (Exploring the Anatomy of Multiprocessor Designs).

Applicants respectfully submit that neither Blackburn nor Cravotta cure the above mentioned deficiencies of Hane and that Hane, Blackburn, and Cravotta, taken alone or in any combination, fail to disclose or suggest *"if the first content does not have a high preference value: determining if the first content comprises at least a first characteristic having an associative correspondence to at least a second characteristic of a second content having a high user preference and recommending the first content to the user only if there is such an associative correspondence,"* as recited in claim 1 and, similarly, in claim 20. Because claims 12-14 depend on and, therefore, contain all of the limitations of claim 1, it is respectfully submitted that these claims are allowable. It is also respectfully submitted that claim 20 and its dependent claim 21 are allowable for at least the foregoing reasons presented with regard to claim 1.

CONCLUSION

In light of the foregoing, Applicants respectfully submit that all of the presently pending claims are in condition for allowance. All issues raised by the Examiner having been addressed, an early and favorable action on the merits is earnestly solicited.

Respectfully submitted,

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